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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,239	10/03/2003	Michael J. Mannion	5647	3554

7590 07/27/2004

Milliken & Company
P.O. Box 1927
Spartanburg, SC 29304

EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/679,239	MANNION ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☒ Claim(s) *3, 4 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 10-17 of copending Application No. 10/679,217. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Present claim 1 is drawn to a thermoplastic comprising at least one nucleator compound represented by general formula (I) and at least one anticaking agent.

Claim 1 of the copending application is drawn to thermoplastic composition comprising at least one anticaking agent and at least one compound represented by general formula (I).

The difference between the two claims is semantic. Whereas one is drawn to a thermoplastic, the other is drawn to a thermoplastic composition. Both claims recite the same compound represented by the same general formula (I). The order of appearance of components is merely reversed.

Present claims 2-13 describe meaningful developments of the invention, and these are faithfully reproduced as claims 2-5 and 10-17 in the copending application. It would have been obvious to one having ordinary skill in the art to practice the claimed invention by following the claims of the copending application and *vice versa* because the two sets of claims describe essentially the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 1 and 2 are objected to because of the following informalities: The claims are replete with exemplary terms "such as," "for example," "for instance," "preferably," and "and the like." These phrases render the claims indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d). Appropriate correction is required.

4. Claim 1 is objected to because of the following informalities: The word "conforming" appears twice successively. Please delete one of the terms. Appropriate correction is required.

5. Claim 3 is objected to because of the following informalities: The recitation "organic cation" is inconsonant with the limitation "Group I and Group II metal ions.". Appropriate correction is required.

6. Claim 4 is objected to because of the following informalities: Silver, zinc, and aluminum do not belong in group I or group II. Appropriate correction is required.

7. Claim 6 is objected to because of the following informalities: Delete the word "any." Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient antecedent basis for the limitation "formulation" in the claims.

10. Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient antecedent basis for the limitation "thermoplastic article" in the claims.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,465,551 to Zhao *et al.* in view of U.S. Patent No. 4,417,999 to Duffy.

Zhao *et al.* teaches polypropylene compositions containing disodium bicyclo[2.2.1]heptane dicarboxylate as nucleating agent (claims 1, 13, 19, 20, experimental tables 1-4). Pellets are made from the inventive compositions (col. 8, line 10), although any form may be exhibited (col. 7, line 8). According to claim 13, at least one antistatic agent additive is incorporated into the composition), however, the identity of the antistatic agent is not disclosed in the reference. Duffy teaches use of an antistatic composition comprising silica gel particulates and ethoxylated alkylamine which is ideally suited for polyolefins such as polyethylene and polypropylene (see claim 2, col. 3, lines 30-32). One having ordinary skill in the art would have found it obvious to use antistatic in propylene compositions of Zhao *et al.*

because this is a claimed feature of the invention, and it would have been obvious to the skilled artisan to use the silica gel/ethoxylated alkylamine because Duffy clearly teaches its use with polypropylene compositions. As such, one would expect such a combination to work sufficiently in imparting antistatic properties to thermoplastic compositions.

The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure. The following references have been cited to show the state of the art with respect to bicyclic dicarboxylate nucleating agents.

U.S. Patent No. 6,759,124 to Royer *et al.*
U.S. Patent No. 6,559,211 to Zhao *et al.*
U.S. Patent No. 5,981,636 to Amos *et al.*
U.S. 2003/0236332 to Dotson *et al.*
WO 98/29494 to Amos *et al.*
WO 02/077092 to Zhao *et al.*
WO 02/094759 to Zhao *et al.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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July 20, 2004

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700